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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/31/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/073,216

Applicant(s)

PIRTTIMAA ET AL.

Examiner

Pramila Parthasarathy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-36 is/are rejected.
- 7) ☒ Claim(s) 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communication filed on 11/13/2006. Claims 1 – 35 are amended and new Claim 36 was added. Currently Claims 1 – 36 are pending.

Double Patenting

2. Applicant's arguments filed November 13, 2006 have been fully considered and are persuasive with respect to copending application 10/202,563 but they are not persuasive with respect to Patent 6,788,676 for the following reasons: Applicant argues that Patent 6,788,676 was filed later than the instant application but agrees that the Patent 6,788,676 was assigned to Nokia Corporation, which is also the assignee of the instant application. The obvious-type rejection was based upon the conflicting invention is claimed in the Patent 6,788,676 by a different inventive entity that is commonly assigned, even though there is no common inventor.

Examiner withdraws double patenting rejection for copending application 10/202,563 and maintains double patenting rejection with Patent 6,788,676. Applicant is advised to file a terminal disclaimer to overcome double patenting rejection.

Response to Arguments

3. Applicant's arguments filed November 13, 2006 have been fully considered but they are not persuasive for the following reasons:

Applicant argues that the cited prior art [Ejzak U.S. Patent 6,996,087, hereafter "Ejzak"], does not teach, "performs protection processing based on comparing first source information and second source information". This argument is not persuasive. Applicant's independent claims recite "comparing first source information and second source information; initiating a protection processing based on a result of said comparing;". Thus Examiner broadly reads, "a protection processing is initiated on a result (**not definitive**) of comparing first and second source information (emphasis added). Furthermore, Ejzak discloses, "authentication, accounting and mapping of IP addresses (comparing source address information), session management (initiation protection processing), and providing secure access (subscriber profile management and service authorization) to packet data network (packet-switched domain) (See Ejzak, Column 3 line 52 – Column 4 lines 9 and Column 6 lines 45 – 54).

Therefore, the examiner respectfully asserts that the cited prior art does teach or suggest the amended subject matter, "performs protection processing based on comparing first source information and second source information" broadly recited in the independent claims. The dependent claims are rejected at least by virtue of their dependency on the dependent claims and by other reason set forth in this office action. Accordingly, the rejection for the pending claims 1 – 36 is respectfully maintained.

Examiner would like to point out that although Examiner had cited particular columns and lines numbers in the references as applied to the claims for the convenience of the applicant, the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim. It is valid that other relevant passages and figures may apply as well to substitute the specified teachings. Therefore, it is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

On further considerations, Examiner has recommended that the Claims 10 – 12 as containing allowable subject matter over prior art (please refer to Allowable Subject matter section #8 of this office action). Examiner suggests applicant to amend the claims in a manner to distinct applicant's invention with prior art with ***attention*** given to the specification paragraphs [0045 – 0047].

Claim Objections

4. Claim 13 is objected to because of the following informalities: Claim 13 recites, "a deriving unit configured to derive a first source and for deriving a second source information". Replace "a deriving unit configured to derive a first source and for

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deriving a second source information" with "a deriving unit configured to derive a first source and **to derive** a second source information" (emphasis added).

Appropriate correction is required.

5. Claims 8 and 9 are duplicate claims depending on Claim 1 and either claim 8 or claim 9 must be cancelled. Examiner rejects both the claims under the same prior art reasoning.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Instant application Claims 1 – 36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 14 of U.S. Patent No. 6,788,676. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant case, all elements of claims 1 – 36 correspond to the claims of 1 – 14 of the patent claims, except in the instant claims, the element, “comparing said first and second source information and dropping message if comparing first source and second source information do not indicate the same location” is referred in the patent claims as “the IMS (IP multimedia subsystem) is able to route subsequent SIP signaling (message) through the IMS proxy (P). It would have been obvious to one having ordinary skill in the art to recognize that providing packet filtering by comparing the first and second source information is equivalent to having an IMS proxy server routing the messages that are registered with the proxy through P-CSCF) filtering.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1 – 9 and 13 – 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Ejzak (U.S. Patent Number 6,996,087).

Regarding Claims 1 and 2, Ejzak teaches receiving a message from a terminal device, connected to said packet data network (Summary and Column 3 line 52 – Column 4 line 9);

deriving a first source information from said message; c) deriving a second source information (Summary and Column 3 line 52 – Column 4 line 9);

comparing said first and second source information; and e) initiating a protection processing based on the result of said comparing step (Summary and Column 3 line 52 – Column 4 line 9); and

providing secure access to said packet data network based on said protection processing (Column 3 line 52 – Column 4 line 9 and Column 6 lines 45 – 54).

Regarding Claim 13, Ejzak teaches a receiving unit configured to receive a message from a terminal device, connected to said packet data network (Summary and Column 3 line 52 – Column 4 line 9);

a deriving unit configured to deriving a first source information from said message, and for deriving a second source information (Summary and Column 3 line 52 – Column 4 line 9);

a comparing unit comparing said first and second source information (Summary and Column 3 line 52 – Column 4 line 9); and

a protecting unit configured to initiate a protecting processing based on a comparing result of said comparing unit and to provide secure access to said packet

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data network based on said protection processing (Column 3 line 52 – Column 4 line 9 and Column 6 lines 45 – 54).

Regarding Claim 36, Ejzak teaches receiving means for receiving a message from a terminal device connected to said network element (Summary and Column 3 line 52 – Column 4 line 9);

deriving means for deriving a first source information from said message, and for deriving a second source information (Summary and Column 3 line 52 – Column 4 line 9);

comparing means for comparing said first source information and second source information (Summary and Column 3 line 52 – Column 4 line 9); and

protecting means for initiating a protecting processing based on a comparing result of said comparing unit and to provide secure access to said packet data network based on said protection processing (Column 3 line 52 – Column 4 line 9 and Column 6 lines 45 – 54).

Claims 3, 14 and 22 are rejected as applied above in rejecting Claims 1, 2 and 13. Furthermore, Ejzak teaches wherein said second source information is a source address information derived from a packet data unit used for conveying said message, or from a security association set up between said terminal device and said packet data network (Summary and Column 3 line 52 – Column 4 line 9 and 26 – 65).

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Claims 4, 16, 23 and 30 are rejected as applied above in rejecting Claims 1, 2, 13 and 29. Furthermore, Ejzak teaches wherein said protection processing comprises a processing for dropping said message if said comparing step leads to the result that said first source information and said second source information do not indicate the same location (Summary and Column 4 lines 26 – 65).

Claims 5, 17, 24 and 31 are rejected as applied above in rejecting Claims 1, 13, 23 and 30. Furthermore, Ejzak teaches wherein said protection processing comprises a processing for dropping said message if said comparing step leads to the result that said first source information and said second source information do not match (Summary and Column 4 lines 26 – 65).

Claims 6 and 25 are rejected as applied above in rejecting Claims 1 and 2. Furthermore, Ejzak teaches wherein said first source information is an IP address (Summary and Column 3 line 52 – Column 4 line 9).

Claims 7 and 26 are rejected as applied above in rejecting Claims 1 and 2. Furthermore, Ejzak teaches wherein said message is a session initiation protocol (Summary and Column 3 line 17 – 23).

Claims 8, 9, 19, 27 and 33 are rejected as applied above in rejecting Claims 1, 2 and 13. Furthermore, Ejzak teaches wherein said second source information is at least a part of an internet protocol source address of an internet protocol datagram (Summary and Column 3 line 52 – Column 4 line 9).

Claims 15 and 29 are rejected as applied above in rejecting Claims 13 and 14. Furthermore, Ejzak teaches wherein said deriving unit is arranged for deriving said first source information from a header portion of said message (Summary and Column 4 lines 26 – 65).

Claims 18 and 32 are rejected as applied above in rejecting Claims 13 and 31. Furthermore, Ejzak teaches wherein said deriving unit are arranged for reading said second source information from a database provided at said network element (Summary and Column 4 lines 26 – 65).

Claims 20 and 34 are rejected as applied above in rejecting Claims 13 and 33. Furthermore, Ejzak teaches wherein said network element is a proxy server (Summary and Column 10 lines 14 – 35).

Claims 21 and 35 are rejected as applied above in rejecting Claims 13 and 34. Furthermore, Ejzak teaches wherein said proxy server is a P-CSCF of an IP Mobility Subsystem (Summary and Column 10 lines 14 – 46).

Claim 28 is rejected as applied above in rejecting Claim 2. Furthermore, Ejzak teaches wherein said message is conveyed using a session initiation protocol-level protection function (Column 3 line 52 – Column 4 line 9 and Column 6 lines 45 – 54).

Allowable Subject Matter

8. Claims 10, 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims along with filing a terminal disclaimer to overcome the double patenting rejection with the Patent 6, 788,676.

Examiner suggests amending Claim 10 to include only the partial limitation from Claim 3, i.e., only to include the limitation of "The method according to claim 1, wherein said second source information is a source address information derived from a security association set up between said terminal device and said packet data network" along with moving the allowed subject matter from Claim 10 and Claim 1. Furthermore, the amended Claim 10 should recite all the limitations of Claim 1, Claim 10 and the above-suggested limitation from Claim 3.

Dependent Claims 11 and 12 are objected to be allowed by the virtue of their dependency from Claim 10.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-232-4195. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

January 19, 2006.

NASSER MOAZZAMI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100


1/26/07